



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,091	11/16/2001	Mark Ireton	7916-005	9462

20306 7590 01/05/2005

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

EXAMINER

LE, UYEN T

ART UNIT PAPER NUMBER

2163

DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/992,091	Applicant(s) IRETON, MARK	
	Examiner Uyen T. Le	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 9, 2004 has been entered.

Response to Amendment

2. Applicant's arguments filed 9 November 2004 have been fully considered but they are moot in view of the new grounds of rejection presented in this Office Action. Applicant seems to argue the claims as amended.

Regarding claim 1, applicant argues that "Rose does not teach a media player including a content database for storing the at least one organizational task to be executed upon connection of the player to a content source as recited in claim 1 and similarly in claim 8". In response, the examiner disagrees. The claimed organizational task to be executed upon connection of the player to a content source is met by the tasks of check-in, check-out shown in Rose (see column 1, line 63- column 2, line 34). The task is executed upon connection to the content source, thus has to be stored on a database as claimed.

Applicant further argues that "Rose does not teach a media player including a content database which manages relationships between content selections and content files, that is separate from a media or content source". In response, those limitations

Art Unit: 2163

are not reflected in the claim language. Claim 1 merely requires "a content database for storing the at least one organizational task to be executed upon connection of the player to a content source". The claimed organizational task to be executed upon connection of the player to a content source is met by the tasks of check-in, check-out shown in Rose (see column 1, line 63- column 2, line 34).

Applicant further argues that "Rose does not teach pre-selection of content to download on the media player". In response, again this limitation is not reflected in the claim language. Claim 1 merely requires "a user interface allowing a user to make content selections". This limitation is met by the fact that the user in the method of Rose selects multimedia assets via a user interface (see Figures 5, 7-16).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 8-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not have enough support for the claimed "database within the player, the database provides a list of content files that includes files not existing on the player".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 2163

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8-18, 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not understood how the database within the player provides a list of content files that includes files not existing on the player as recited in claim 8.

It is not understood how the selection of content files after being added to the database within the player does not exist on the player as recited in claim 16.

Claim 22 indicated as original is not the original claim although no part of it is underlined to show any amendment. Furthermore, last two lines "causing the machine to transfer the content file to the content delete at least one content file on the media player" is not understood.

Art rejection to claims 8-18, 22 is not being applied because the limitations cannot be ascertained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Rose et al (US 5,752,244).

Regarding claim 1, Rose discloses the claimed media player including a storage to store content files (see the abstract), a user interface allowing a user to make content selections (see Figure 5), a content database to manage relationships between content selections and the content files (see item 21 in Figure 4), a processor to perform at least one organization task on at least one of the content files based upon the content selection (see column 25, lines 6-47). The claimed content database merely stores at least one organizational task to be executed upon connection of the player to a content source. The media player of Rose clearly includes such a database since it executes an organization task upon connection of the player to a content source (see check-in, column 1, line 62- column 2, line 5).

Regarding claims 2, 3, Rose discloses that the content files are music files and video files (see the abstract).

Regarding claim 4, Rose discloses a user interface including a display and control buttons (see Figure 5).

Regarding claim 5, Rose discloses a user interface comprising a display and alphanumeric keypad when Rose shows that the client computer is a personal computer with Window operating system (see column 25, lines 26-32).

Regarding claim 6, Rose discloses sorting the content files when Rose shows that the projects are indexed in the project table 80 (see column 7, lines 1-3).

Regarding claim 7, Rose discloses searching the content files (see Browser/Search in Figure 4).

6. Claims 19-21, 23, 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Lamkin et al (US 20040220926).

Regarding claim 19, Lamkin discloses all the claimed subject matter (see Figure 17, 0027-0028, 0121, 0462), including “receive a user input...content files” (0027), “access a database within the machine” (local content source 2104) “wherein the database provides a list of content files associated with the selection of content files” (collection metadata), “connect the machine” (player) “to a source of content” (offsite content source 2106) and “execute predefined rules to perform at least one operation on content files associated with the selection of content files after connection to the source of content” (download only entities that meet a set of criteria).

Regarding claim 20, Lamkin discloses wherein the code when executed causes the machine to add content files to the media player (downloading, 0027).

Regarding claim 21, Lamkin discloses wherein the code when executed causes the machine to delete at least one content file on the media player (0037).

Regarding claim 23, Lamkin discloses wherein the code when executed causes the machine to transfer content to fill play lists (downloading 0027).

Regarding claim 24, Lamkin discloses wherein the code when executed causes the machine to transfer content across play lists (0271).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T. Le whose telephone number is 571-272-4021. The examiner can normally be reached on M-F 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

13 December 2004


UYEN LE
PRIMARY EXAMINER